

## REMARKS

Reconsideration of this application, as amended, is respectfully requested.

### **I     Status of the Claims**

Claims 9 and 64 have been amended.

Claims 1-13 and 57-68 are pending.

Amendments to claims 9 and 64 add no new matter.

### **II    Rejections Under 35 U.S.C. § 112**

Claims 9 and 64 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Applicants respectfully submit that claims 9 and 64 have been amended so as to no longer recite the lipstick feature of the invention. Thus, Applicants respectfully request that the above rejection be withdrawn.

### **III   Rejections Under 35 U.S.C. § 103(a)**

Claims 1-13 and 56-67 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 1,499,784 to Recker in view of U.S. Patent No. 6,050,540 to O'Reilly. The Examiner states in regard to claims 1, 3, 4, 5, 12, 57-60, 67 and 68, that Recker discloses a cosmetic applicator comprised of a container 10, 11, having smooth interior and exterior contours, wherein composition 17 is in sliding contact with the walls and is advanceable and retractable in the container and wherein the walls proximate to the

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composition are rigid throughout and a screw 15 rotatably connected to the container and disposed within the composition in order to advance/retract the composition when turned. However, the Examiner admits that Recker does not disclose the composition being formed from two different compositions. The Examiner states that O'Reilly discloses another lipstick product wherein the product is formed from two compositions 25, 28, which differ in color to form a predetermined multi-color image in order to enhance the appearance of the product. Additionally, the Examiner states that O'Reilly discloses that the product can not only be a lipstick, but also a lip balm. Thus, the Examiner states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a two composition product into Recker's container in order to enable a user to easily apply a two composition product based on the teachings of O'Reilly. Applicants respectfully traverse the above rejection.

Applicants submit that the Examiner has not made a case of *prima facie* obviousness. Neither Recker nor O'Reilly, alone or in combination, teach or suggest all of the claimed features of claims 1, 12 and 57. Claims 1, 12 and 57 recite the feature that the molded stick composition "appears transparent or translucent when applied to a substrate". The Examiner contends that O'Reilly discloses the above feature of the present claims in the following disclosure:

Since many modifications, variations and changes in detail can be made to the described preferred embodiment of the invention, such as by way of one example only, desiring to make an alternative customized lipstick product not directed only to color but to the providing of a higher wax content and/or protective lip balm either alone or in combination with color.

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O'Reilly, column 12, line 62 to column 13, line 1. Applicants respectfully disagree with the Examiner's interpretation of O'Reilly. O'Reilly, read as a whole, does not teach or suggest a stick product that "appears transparent or translucent when applied to a substrate." O'Reilly is directed to an apparatus "to form either a traditional lipstick from a single color or a blend of colors, or a lipstick having at least two separately colored segments, most preferably comprising two separately colored longitudinal halves." O'Reilly, column 2, lines 46-49. All of the teaching of the reference is directed to a lipstick or combining two lipsticks, or at best a pigmented composition combined with a non-pigmented composition (e.g., protective lip balm), not a transparent or translucent product. Some of O'Reilly's stated advantages are to allow users to: recycle old lipstick to avoid waste, combine two colored halves into one lipstick for a "customized" look, and to blend multiple colors to form one new color. *See, e.g.*, O'Reilly, column 3, line 62 to column 4, line 32. Additionally, all of the figures illustrating O'Reilly's invention show a mold designed to form a lipstick, not a lip balm. Thus, given the above, when O'Reilly states that one can "make an alternative customized lipstick product not directed only to color but to the providing of a higher wax content and/or protective lip balm either alone or in combination with color" one of ordinary skill in the art would not be motivated to make a stick product in which both components are transparent or translucent upon application to the substrate. One of skill in the art is at best motivated by O'Reilly to form a lipstick of half lip balm and half lipstick in accordance with the teachings of O'Reilly as a whole. A half lipstick/half lip balm combination does not appear transparent or translucent when applied.

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Regarding claim 67, the claim recites the feature that the first and second compositions have a first and second color and the second color provides good contrast with the first color. This limitation is not taught or suggested in either Recker or O'Reilly. Particularly, O'Reilly states that the object of her invention results "in a single lipstick tube which offers the chosen 'customized' look or shade ... for example, by lightening or darkening or otherwise altering the color of a selected main or base shade." O'Reilly, column 2, lines 35-40. The specification of the present invention gives examples of contrasting color combinations, e.g. red and green, yellow and purple and orange and brown (see, page 9, lines 14-30). These color schemes are in contrast to the stated object of O'Reilly's invention. One of ordinary skill in the lipstick arts is not taught or motivated by O'Reilly to produce a lipstick product with such contrasting color combinations. Applicants respectfully state that both Recker and O'Reilly fail to teach or suggest the invention of claim 67.

Regarding claim 2, Applicants respectfully disagree with the Examiner's statement that Recker discloses the claimed feature "wherein the interior and exterior contours of the container are different." Recker "employ[s] a tubular cosmetic-container 10, oval in cross-section .... [with] a removable cap 11." Recker, page 1, lines 47-53, *see, also*, Figures 1-6. Recker discloses container 10 having identical interior and exterior contours. Recker's removable cap 11 is not part of the container, but a separate element. Additionally, O'Reilly does not cure the deficiencies in the teachings of Recker. Thus, neither Recker nor O'Reilly teach or suggest the claimed invention.

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Regarding claims 9 and 64, the Applicants have amended the claims to remove the feature that the stick composition is lipstick. Applicants respectfully state that neither Recker nor O'Reilly teach or suggest the remaining claimed features of claims 9 and 64.

Claims 2-11, 13, 58-66, and 68 all depend from independent claims 1, 12, 57 and 67 and are patentable over the prior art based on their own recital.

Given the above, Applicants respectfully request that the above rejections be withdrawn.

### CONCLUSION

In view of the foregoing, it is believed that claims 1-13 and 57-68 are in condition for allowance and is respectfully requested that the application be reconsidered and that all pending claims be allowed and that the case is passed to issue.

If there are any other issues remaining to be examined or believed to be resolved to either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Respectfully submitted,



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EXPRESS MAIL CERTIFICATE



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I hereby certify that, on the date indicated above, this paper or fee was deposited with the U.S. Postal Service & that it was addressed for delivery to the Assistant Commissioner for Patents, Washington, DC 20231 by "Express Mail Post Office to Addressee" service.

D. Davis D. Davis  
Name (Print) Signature

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Docket No: 0630/0G528

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: J. LOOK, et al.

Serial No. 09/584,640

Art Unit: 3751

Confirmation No.: 4278

Filed: May 31, 2000

Examiner: D. Walczak

For: **MULTI-COMPOSITION STICK PRODUCT AND A PROCESS AND SYSTEM FOR MANUFACTURING THE SAME**

**MARK-UP FOR AMENDMENT**

February 28, 2003

Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

In response to the Office Action dated November 21, 2002, please amend the application as follows:

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**IN THE CLAIMS:**

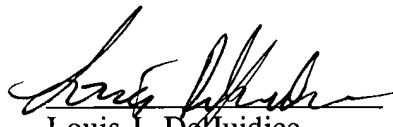
Please amend the claims pursuant to 37 C.F.R. § 1.121 as follows:

Please replace claims 9 and 64 with the following amended claims 9 and 64.

9. (Amended) The multi-composition stick product in accordance with claim 8, wherein the stick composition is lip balm, [lipstick,] lip gloss, sunscreen stick, or deodorant.

64. (Amended) The multi-composition stick product in accordance with claim 63, wherein the stick composition is lip balm, [lipstick,] lip gloss, sunscreen stick, or deodorant.

Respectfully submitted,



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